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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/692,501	10/24/2003	Michael Shappell	224558	9299

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EXAMINER

LIN, SHEW FEN

ART UNIT	PAPER NUMBER
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2166

DATE MAILED: 04/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/692,501

Applicant(s)

SHAPPELL ET AL.

Examiner

Shew-Fen Lin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 October 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) 11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 10/24/03, 3/24/05, 4
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Detail Action

- a. This action is responsive to communications: application filed on October 24, 2003, IDS filed on October 24, 2003, March 24, 2005, and April 18, 2005.
- b. Claims 1-10 are pending in this Office Action. Claims 1, 5, and 9 are independent claims.

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-10, drawn to a method to generate files in a shared environment, classified in class 707, subclass 102.
- II. Claim 11, drawn to a system using graphical user interface to browse and navigate files, classified in class 715, subclass 738.

The inventions are distinct, each from the other because of the following reasons:

Inventions in Group I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention in Group I has separate utility such as a method to generate files in a shared environment. See MPEP § 806.05(d). Invention in Group II has separate utility and a system using graphical user interface to browse and navigate files.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

During a telephone conversation with applicant attorney William J. Kramer on April 14, 2006 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-10. Affirmation of this election must be made by applicant in replying to this Office action. Claim 11 is withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Drawings

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: "an Open window 504 is presented" in page 15, paragraph [0051], line 5. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are

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not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-5 are rejected under 35 U.S.C. 102(e) as being anticipated by Aboulhosn et al. (US Patent 6,938,042, hereinafter referred as Aboulhosn).

As to claim 1, Aboulhosn discloses a method of enabling file sharing over a computer network among members of a group (column 1, lines 59-60) comprising a first user and at least one other user comprising:

displaying to the first user via a first user graphical display a shared space indicator (Figure 1, column 3, lines 66-67, column 4, lines 1-2) including a first file object associated with the shared space first group comprising the first user and at least one other user (Figures 2-3, Figure 5, item 513, column 4, lines 1-12);

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receiving from the first user a request to perform a file system operation with respect to the file object (column 4, lines 9-12); and

sending a communication over the network to a computing device used by the at least one other user to indicate that the shared file has been modified by the first user after such file system operation has been performed (column 2, lines 18-20, lines 44-47).

As to claim 2, Aboulhosn discloses wherein the network is a peer-to-peer network (column 2, lines 15-18).

As to claim 3, Aboulhosn discloses presenting a graphical representation of the file system operation to the first user in response to receiving the file system operation request (Figure 1, column 3, lines 66-67, column 4, lines 9-12).

As to claim 4, Aboulhosn discloses wherein a graphical representation of the shared file modification is displayed on the computing device used by the at least one other user (Figures 2-3, column 4, lines 13-23, lines 49-59, column 6, lines 38-40).

As to claim 5, Aboulhosn discloses a method for updating a shared file in a computer network including a group of communicating computing devices in a peer-to-peer network (Figure 6B), the method comprising

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performing, at a first computing devices, a file system operation on a shared file associated with a file icon displayed in a first shared space display area to generate an updated shared file (Figure 1, column 4, lines 1-12, column 2, line 67);

creating, at the first computing device, metadata associated with the updated shared file (column 2, lines 36-40);

propagating, by the first computing device, the metadata associated with the updated shared file to other group member (column 2, lines 18-20);

obtaining, by a second computing device, the metadata associated with the updated shared file (column 2, lines 24-27, lines 40-41);

determining, by the second computing device, whether the updated shared file should be replicated on the second computing device (column 2, lines 3-7);

downloading, by the second computing device, the updated shared file when it is determined that the updated shared file should be replicated (column 2, lines 3-7); and

displaying a second file icon in the shared space display area of the second computing device indicating that the shared file has been updated (Figures 2-4, column 4, lines 13-23, column 6, lines 38-40).

Claims 9-10 are rejected under 35 U.S.C. 102(e) as being anticipated by Balfanz et al. (US Publish 2004/0103280, hereinafter referred as Balfanz).

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As to **claim 9**, Balfanz discloses a method for adding a shared file to a shared space indicated by a display on a computing device in a computer network that includes a first online member of a group and at least one other online member of the group (Figure 1, paragraph [0007], lines 4-9), the method including the steps of:

displaying to the first user via a first user display a group folder object (Figures 3A/B, paragraph [0031], lines 1-3, paragraph [0032], lines 13-16) ;

activating a file system operation through selection of a first selectable visual indicator to move a file into the group folder object (paragraph [0033], lines 1-8);

creating metadata concerning the moved file (paragraph [0033], lines 8-13); and

transmitting the metadata to the at least one other online member of the group (paragraph [0059]).

As to **claim 10**, Balfanz discloses wherein the network is a peer-to-peer network (column 2, lines 15-18).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aboulhosn as applied to claim 5 above, and further in view of Taylor et al. (US Patent 5,754,306, hereinafter referred as Taylor).

As to claims 6 and 7, Aboulhosn discloses the elements of claim 5 as noted above but does not explicitly disclose the step of displaying, by the second computing device, a third file icon in the shared space display area indicating that the shared file has not been updated when the updated shared file should not be replicated on the second computing device.

Taylor discloses the step of displaying a third file icon when the file has not be updated (Figure 20A, column 28, lines 3-6).

It would have been obvious to a person of ordinary skill in the art at the time of invention was made to modify Aboulhosn's disclosure to include different display for unsynchronized files as taught by Taylor for the purpose of identifying unsynchronized files (column 27, lines 23-26, Taylor). The skilled artisan would have been motivated to improve the invention of Aboulhosn

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per the above such that different icon is used to indicated the file is not updated (column 27, lines 23-29, Taylor).

As to claim 8, Aboulhosn discloses wherein the first shared space display area is a folder object (Figure1, column 3, lines 66-67, column 5, lines 17-19).

Related Prior Arts

The following list of prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Scott, Adrian C.H. et al., US 20020049760 A1, "Technique for accessing information in a peer-to-peer network", (...sharing files in a peer-to-peer network based on the hashed ID).
- Kirnos, Ilya, US 20020188667 A1, "Management and synchronization application for network file system", (...mapping network files to detecting alterations to file systems for purpose of synchronization).
- Wlaschin; Scott, US 5790848 A, "Method and apparatus for data access and update in a shared file environment", (...storing, retrieving, and sharing data items across multiple physical storage devices that may not always be connected with one another).

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- Cragun; Brian John, US 6557028 B2 , "Method and computer program product for implementing collaborative bookmarks and synchronized bookmark lists", (...collaborative bookmarks and synchronized bookmark lists, ...User selected changes are identified and the bookmark list is updated. A bookmark list is received by a user, ... update records can be created in e-mail and bookmark lists are synchronized by sending e-mail messages to each participant).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shew-Fen Lin whose telephone number is 571-272-2672. The examiner can normally be reached on 8:30AM - 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hosain Alam can be reached on 571-272-3978. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Shew-Fen Lin
Patent Examiner


MOHAMMAD ALI
PRIMARY EXAMINER

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April 14, 2006